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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,630	04/22/2004	Dennis R. Raffaelli	INL-00059	7299
7590 02/21/2006			EXAMINER	
Warn, Burgess & Hoffmann, P.C. P.O. Box 70098 Rochester, MI 48307			NGUYEN, DUNG V	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SR

<b>Office Action Summary</b>	<b>Application No.</b> 10/829,630	<b>Applicant(s)</b> RAFFAELLI, DENNIS R.	
	<b>Examiner</b> Dung V. Nguyen	<b>Art Unit</b> 3723	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 2,8-14,16,22-28,30 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,15,17-21,29 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6, 7, 15, 20, 21, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Videcoq et al (USPN 5,951,381) in view of Robichon (USPN 5,846,125). Videcoq et al discloses a rotary edging wheel 1 and method of use for rough cutting of an optical lens 14 comprising a hub portion 2 operable for attaching to a rotary power source 11, wherein the hub portion includes a substantially solid body member 2, an outer circumferential rough cutting surface 3 having a width L, wherein the surface 3 is adjacent to the body member 2, the surface 3 including an abrasive grit attached thereto, wherein the abrasive grit is diamond grit and operable for rough cutting of the optical lens 14 (note Fig. 1, col., line 66 to col. 2, line 40). However, Videcoq et al does not disclose the abrasive grit is present at a substantially level depth, at least one pair of grooves formed in the surface comprising a first groove extending at an angle across the surface, a second groove extending at an angle across the surface, wherein the first and second grooves are angled either towards each other or away from each other and extend continuously across the surface. Robichon discloses an abrasive grit is present at a substantially level depth, at least one pair of grooves 11 formed in the surface 7 comprising a first groove extending at an angle across the

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surface, a second groove extending at an angle across the surface, wherein the first and second grooves are angled either towards each other or away from each other and extend continuously across the surface 7, wherein the abrasive grit 10 is attached to the wheel by resin bonding (note Fig. 1 and 2, col. 1, lines 24-42, col. 2, line 58 to col. 3, line 44). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the surface of Videcoq et al with grooves as disclosed by Robichon in order to take away heat produced in the grinding work and carry away the cuttings produced far from the work area.

3. Claims 3-5 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Videcoq et al (USPN 5,951,381) in view of Robichon (USPN 5,846,125). Videcoq et al, as modified by Robichon, lacks each groove has an angle of from about 10 degrees to about 80 degrees, about 15 degrees to about 65 degrees, about 35 degrees to about 45 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select each groove has an angle of from about 10 degrees to about 80 degrees, about 15 degrees to about 65 degrees, about 35 degrees to about 45 degrees, since it has been held that where the general conditions of a claim is disclosed in the prior art, discovering the optimum or workable ranges involve only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Response to Arguments***

4. Applicant's arguments filed 23 January 2006 have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

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established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine the reference is found in the knowledge generally available to one of ordinary skill in the art. Furthermore, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Videcop et al and Robichon in combination disclose all the limitations of claims 1, 6, 7, 15, 20, 21, 29 and 31 as described in the rejections above.

### **Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung V. Nguyen whose telephone number is 571-272-4490. The examiner can normally be reached on M-F, 7:00-3:30.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on 571-272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**DUNG VAN NGUYEN**  
**PRIMARY EXAMINER**

DVN  
February 14, 2006